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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,420	08/27/2003	Tim Terakita	10251-001	5301
29391	7590	06/15/2005	EXAMINER	
BEUSSE BROWNLEE WOLTER MORA & MAIRE, P. A. 390 NORTH ORANGE AVENUE SUITE 2500 ORLANDO, FL 32801			WILLIAMS, KENNETH C	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/649,420

Applicant(s)

TERAKITA ET AL.

Examiner

Kenneth C. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/27/2003
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Election/Restrictions***

1. Applicant's election with traverse of a therapeutic body area-specific covering in the reply filed on May 3, 2005 is acknowledged. The traversal is on the ground(s) that Figure 5 contains a gel pack, element 20, which is a critical element to the various embodiments claimed in the application. This is found persuasive because the current examiner finds element 20 is vital to the disclosed device, therefore claims 1-29 will be examined.

***Oath/Declaration***

2. A new oath or declaration is required because the incorrect U.S. Parent Application Number is cited. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: element 6 (page 7, line 15), element 16 (page 7, line 19), and element 32 (page 9, line 8). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of

the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

4. The use of the trademark VELCRO has been noted in this application. It should be capitalized in its entirety wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. The disclosure is objected to because of the following informality: the incorrect figure is cited on page 8, line 11, in which "the flaps 16,18 are not permanently connected, but are removable for the bra 5."

Appropriate correction is required.

#### ***Claim Objections***

6. Claims 2 and 8 are objected to because of the following informalities:

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- a. Claim 2 discloses "The therapeutic body covering of claim 1 wherein said removable panel further comprises a second removable panel to form a therapeutic sleeve that has an opening to receive said therapeutic insert." "Said removable panel" lacks proper antecedent basis in claim 1.
- b. Claim 8 discloses "a back panel having a first end connected to said front panel and a second end connected to said second panel." It is unclear as to if both panels are the first and second front panels that cover the first and second breasts.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1,4-8,11-13,15-19,21-24, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Swanger (U.S. Design Patent No. US D446629). Figures 2 and 6 from Swanger are found below and are used as references in the following rejections.
9. In regards to claim 1, Swanger discloses a therapeutic body covering comprising "a panel for covering a certain area of a body", (element 1), "a removable flap positioned over said panel", (element 2), "a therapeutic insert

configured to conform to said area of said body", (element 3), "a securing panel to hold said panel to said certain area of said body", (element 4), "wherein said panel and said securing panel are configured so that said certain area of said body is not moved when placing said therapeutic insert between and removing said therapeutic insert from said panel and said flap." (element 4).

10. In regards to claim 4, Swanger discloses "said therapeutic insert comprises a material that maintains at least one of a cooling temperature for an extended period of time and a warming temperature for an extended period of time." (See Swanger description of Figure 6).

11. In regards to claim 5, Swanger discloses "said therapeutic insert comprises a preformed shape that conforms to a shape of said certain area of said body." (element 3).

12. In regards to claim 6, Swanger discloses "said securing panel is adjustable to allow said therapeutic body covering to best fit to said certain area of said body." (element 5).

13. In regards to claim 7, Swanger discloses "said certain area of said body comprises at least one of a knee area, a shoulder area, an elbow area, an ankle area, and a mammary gland area." (See Swanger Figure 6 below).

14. In regards to claim 8, Swanger discloses "a first front panel for covering a first breast." (element 1), "a second front panel for covering a second breast." (element 1), "a closure device holding said first panel and said second panel together" (element 4), "a back panel having a first end connected to said front panel and second end connected to said second panel." (element 6), "a

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removable first flap positioned over said first front panel." (element 2), "a removable second flap positioned over said second front panel." (element 2), "a therapeutic insert." (element 3), "wherein said therapeutic insert is configured to conform to a breast size." (element 3), "wherein said first front panel, said second front panel, and said back panel are configured so that said breasts are not moved when placing said therapeutic insert between and removing said therapeutic insert from at least one of said first front panel with said first flap and said second front panel with said second flap." (See Swanger Figure 6 below).

15. In regards to claim 11, Swanger discloses "wherein each of said flaps is permanently affixed to each of said respective panels wherein said first flap opens to allow at least one of a placement and a removal of said therapeutic insert between said first flap and said first panel without moving said breast and said second flap opens to allow at least one of placement and removal of said therapeutic insert between said second flap and said second panel without moving said breast" (element 7, the broken lines show stitching).

16. In regards to claim 12, Swanger discloses "a first strap and a second strap wherein said first strap has a first end connected to said first panel and a second end connected to said back panel and said second strap has a first end connected to said second panel and a second end connected to said back panel" (See Swanger Figure 6 below).

17. In regards to claim 13, Swanger discloses "wherein detachable fasteners connect said first flap to said first panel and said second flap to said second panel" (element 8).

18. In regards to claim 15, Swanger discloses "wherein at least one of said first panel and said second panel comprises two pieces of material wherein an opening is provided between said pieces of material for placement of said therapeutic insert" (See Swanger Figure 6 below, arrows drawn from element 3 show location of opening).

19. In regards to claim 16, Swanger discloses "wherein said opening further comprises a reinforced edge around said opening to further prevent movement of said breast when at least one of removing said therapeutic insert and inserting said therapeutic insert" (element 7).

20. In regards to claim 17, Swanger discloses "a therapeutic bra for reducing movement of a breast when applying at least one of a cooling compress and a warming compress to said breast comprising a first bra cup covering a first breast" (element 1), "a second bra cup covering a second breast" (element 1), "a first bra cup flap removable from an outer edge of said first bra cup" (element 2), "a second bra cup flap removable from an outer edge of said second bra cup" (element 2), "a back strap having a first end connected to said first bra cup and a second end connected to said second bra cup" (element 6), "at least one of a cooling compress and a warming compress formed to a shape of at least one of said first breast and said second breast" (element 3), "wherein at least one of said cooling compress and said warming compress fits between at least one of said first bra cup flap connected to said first bra cup and said second bra cup flap connected to said second bra cup" (See Swanger Figure 6 below, arrows drawn from element 3 show location of opening).

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21. In regards to claim 18, Swanger discloses "wherein at least one of said cooling compress and said warming compress are formed to contour to at least one of said breasts" (element 3).

22. In regards to claim 19, Swanger discloses "wherein said first bra cup flap has a first edge that is permanently affixed to a first edge of said first bra cup and wherein said second bra cup flap has a first edge that is permanently affixed to a first edge of said second bra cup" (element 7).

23. In regards to claim 21, Swanger discloses "comprises fasteners to connect at least one of said first bra cup flap to said first bra cup and said second bra cup flap to said second bra cup" (element 8).

24. In regards to claim 22, Swanger discloses "comprises a front closure device connecting said first bra cup to said second bra cup along adjacent edges of each respective bra cup" (element 4).

25. In regards to claim 23, Swanger discloses "comprises a first strap having one end connected to said first bra cup and a second end connected to said back panel and a second strap having one end connected to said second bra cup and a second end connected to said back panel" (See Swanger Figure 2 below).

26. In regards to claim 24, Swanger discloses "wherein said straps are adjustable" (element 5).

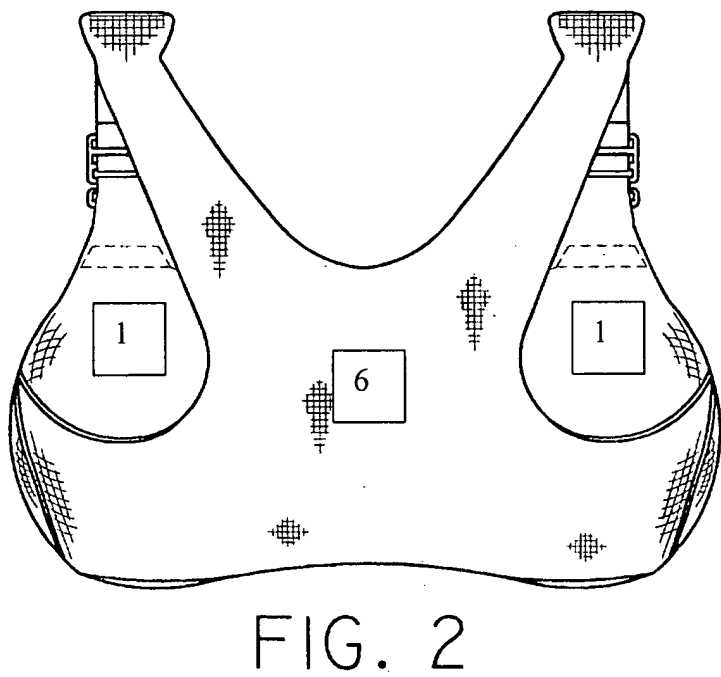
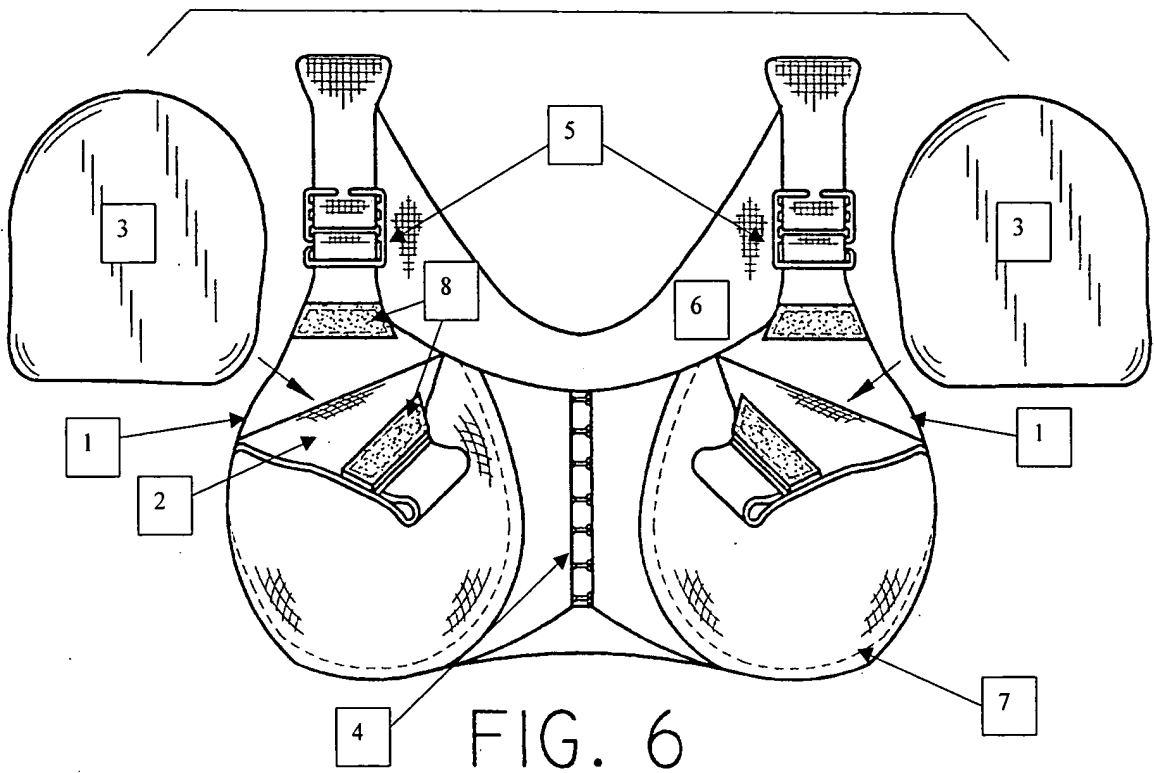
27. In regards to claim 27, Swanger discloses "wherein at least one of said first flap and said second flap comprises two pieces of material wherein an opening is provided between said pieces of material for placement of said

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therapeutic insert" (See Swanger Figure 6 below, arrows drawn from element 3 show location of opening).

28. In regards to claim 28, Swanger discloses "an improvement to a bra having a first bra cup and a second bra cup, said improvement comprising a first movable flap covering a first bra cup" (element 2), "a second movable flap covering a second bra cup" (element 2), "therapeutic inserts that fits between each first flap in combination with said first bra cup and said second flap in combination with said second bra cup" (element 3), "wherein each said flap can be opened for insertion and removal of said therapeutics where a breast is not moved" (element 8).

29. In regards to claim 29, Swanger discloses "comprising said therapeutic insert being conformed to a shape of a breast" (element 3).



***Claim Rejections - 35 USC § 103***

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

32. Claims 2,3,9, 10 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanger (U.S. Design Patent No. D446629) in view of Cipolla (U.S. Patent No. 5458628).

Swanger discloses "a therapeutic body covering comprising a panel for covering a certain area of a body, a removable flap positioned over said panel, a therapeutic insert configured to conform to said area of said body, a securing panel to hold said panel to said certain area of said body, and wherein said panel and said securing panel are configured so that said certain area of said body is not moved when placing said therapeutic insert between and removing said therapeutic insert from said panel and said flap"

Swanger does not disclose "wherein said removable panel further comprises a second removable panel to form a therapeutic sleeve that has an opening to receive said therapeutic inserts" nor "wherein said therapeutic sleeve further comprises a liquid repellant inner liner". Attention is directed to the Cipolla reference, which in a similar field of endeavor, discloses a heating pad with a cover or therapeutic sleeve. The cover material is non-absorbent and moisture or liquid impervious. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use a therapeutic sleeve such as that taught by Cipolla on the thermal insert of Swanger in order to prevent soiling or contamination of the therapeutic body covering by the cooling or warming therapeutic insert.

33. Claims 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanger (U.S. Design Patent No. D446629) in view of Merkovsky (U.S. Patent No. 6346027).

As noted above, Swanger discloses a therapeutic bra including a removable panel to allow a therapeutic insert to be inserted or removed from the therapeutic bra.

Swanger does not disclose "wherein at least one of said first panel and said second panel further comprise an opening to allow for access to a breast nipple when at least one of said first flap and said second flap are removed", but attention is given to the Merkovsky reference, which discloses a nursing bra device for preventing breast milk from leaking through a bra. It would have been obvious to one having ordinary skill in the art at the time the invention was made

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to add a missing opening as taught by Merkovsky to the bra of Swanger in order to allow women who are nursing a bra that will aid in the reduction of swelling and engorgement of the breasts.

34. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swanger (U.S. Design Patent No. D446629) in view of Miller (U.S. Patent No. 5839942).

As noted previously, Swanger discloses a therapeutic bra including a removable panel to allow a therapeutic insert to be inserted or removed from the therapeutic bra.

Swanger does not explicitly disclose "wherein said cooling compress and said warming compress are a single compress having a material that can be both cooled to maintain a given cool temperature for an extended period of time and warmed to maintain a given warm temperature for an extended period of time". Miller discloses a post-partum breast engorgement bra that contains a therapeutic insert in which the cooling and warming function is provided by a single cooling and warming solution. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to make the cool pack of Swanger both a hot and cold pack in light of the teaching of Miller of the desirability to do so and in order to allow the wearer the ability to selectively integrate warmth or coolness.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth C. Williams whose telephone

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number is (571) 272-8161. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KCW

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